

### **III. Remarks**

#### **A. Status of the Application**

No new claims have been added since the last amendment, so claims 1-30 and 37-44 will be pending after entry of the present paper. Claims 1, 5 and 13 have been amended by the present paper and claims 11, 12, and 31-36 were previously withdrawn for being directed to a non-elected species. No new matter is added by the amendments or new claims. Reconsideration of claims 1-10, 13-30, and 41-44 is requested in light of the above-amendments and the following remarks.

#### **C. Claim Rejections – 35 U.S.C. § 103**

**Claims 1-10, 13-30, and 37-39** stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,368,350 to Erickson et al. (“Erickson”) in view of U.S. Patent No. 6,706,068 to Ferree (“Ferree”). As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that the examiner cannot factually support a *prima facie* case of obviousness with respect to claims 1-10, 13-30, and 37-39.

With respect to amended independent claim 1, even when combined, Erickson and Ferree fail to disclose or suggest, a prosthetic device having a “projection being offset in an anterior direction relative to a first center point of the first articular surface; and ... [a] recess being offset in a posterior direction relative to a second center point of the second articular surface ... ,” as recited in claim 1.

While Erickson’s Figure 7 does teach that a projection and a corresponding engaging recess can be located somewhere other than centrally, neither Erickson nor Ferree teach that a projection and a corresponding “engag[ing]” recess may be offset from their respective components in opposite directions, respectively. That is, neither reference show a projection in one direction (e.g., anterior) and a recess in another direction (e.g., posterior).

In lieu of this missing element, the Examiner states that “[t]he implant of Erickson et al. (as modified by Ferree) has an offset configuration as set forth above and there is nothing to prevent, e.g., the upper portion from being turned around in the other direction such that the components are offset in opposite directions, if desired.” May 14, 2010, Office action at p. 3. This statement is the type of conclusory statement (and analysis) expressly forbidden by the M.P.E.P. (as well as the Federal Circuit):

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

M.P.E.P. §2142. Here, not only is there no motivation to combine the references and/or "turn around" a portion of an implant, but there is no explanation or reasoning as to how the implant of Erickson can function if its upper portion was "turned around." Indeed, such a suggestion is far from a "predictable" result as outlined in *KSR*. The only suggestion for doing so and the only disclosure for how such an implant would work are found in the instant application.

Independent claims 13 and 41 have structural distinctions similar to claim 1, each of which are not present in either Erickson or Ferree.

Claims 2-10 depend from and further limit independent claim 1, claims 14-30 depend from claim 13 and claims 42-44 depend from claim 41. Thus, these claims are patentable for the reasons stated above with respect to the independent claims.

Therefore, Applicants respectfully request that the pending §103 rejections be withdrawn.

In light of the continuing prosecution of this case, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

  
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